

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES H. PICKAR

Appeal 2006-3012
Application 09/808,878
Technology Center 1600

Decided: September 7, 2007

Before DEMETRA J. MILLS, ERIC GRIMES, and NANCY J. LINCK,
Administrative Patent Judges.

GRIMES, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellant has requested rehearing (reconsideration) of the decision entered January 31, 2007. That decision affirmed the Examiner's rejection of claims 7, 11, 12, and 69 under 35 U.S.C. § 103. We grant Appellant's request to the extent of designating the affirmance a new ground of rejection, but decline to make any substantive change in the previous decision.

DISCUSSION

Appellant argues that the previous decision mischaracterizes his position regarding what effect would have been expected from using the lower dosages of MPA and CEE disclosed by Plunkett (Req. Rhg. 6-7). Appellant argues that the First Lobo Declaration states that the lower doses would have been expected to be less effective, not “*unsuccessful* in controlling hot flushes,” as we stated in the previous decision.

The cited statement in the previous decision characterized the following argument in the Appeal Brief:

Dr. Lobo states that the results of the study . . . showing that the lower doses of CEE and MPA reduced the number and severity of hot flushes, were contrary to what would have been expected by those skilled in the art. ([Second] Lobo Declaration ¶ 6). Accordingly, the teachings of the prior art and the knowledge generally available in the art would not have suggested to those skilled in the art that the [claimed dosages] would have been reasonably successful in providing relief of vasomotor symptoms of menopause.

Thus, the statement in the previous decision appears to accurately reflect the argument to which it responded. In any event, Appellant’s argument based on the First Lobo Declaration is addressed in a different part of the previous decision (pages 9-11). Appellant’s position regarding the allegedly unexpected results was correctly understood and addressed.

Appellant also argues that the affirmance should be designated a new ground of rejection. Appellant points to our identification of Plunkett’s claim 42 as the closest prior art (previous decision, at 12) as a rationale that the Examiner had not raised (Req. Rhg. 4-5). Appellant also argues that the Examiner did not rely on Utian, as we did, as evidence that the data in the

Specification would not have been considered unexpected (*id.* at 5-6).

Appellant argues that, in view of these new rationales, “the Board’s decision constitutes a new ground of rejection for which Appellants [sic] should be given a full and fair opportunity for response under § 41.50(b)” (*id.* at 6).

“[T]he ultimate criterion of whether a rejection is considered ‘new’ in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection.” *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976). We do not believe that the basis of the affirmance in the decision of January 31, 2007, changed the basic thrust of the rejection.

That said, however, it is true that the Examiner had not identified Plunkett’s claim 42 as the closest prior art embodiment. It is also true that Appellant may have submitted different or additional evidence to rebut the rejection if the Examiner had focused attention on that prior art embodiment. Therefore, even though we do not consider it strictly required under the *Kronig* standard, we will designate our affirmance of the Examiner’s rejection as a new ground of rejection under 37 C.F.R. § 41.50(b), to give Appellant an opportunity to address the method of Plunkett’s claim 42 as the closest prior art embodiment.

Appellant should note, however, that the response must include “an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.” 37 C.F.R. § 41.50(b). “If the appellant submits an argument without either an appropriate amendment or new evidence as to any of the claims rejected by the Board, it will be treated as a request for rehearing under 37 C.F.R. 41.50(b)(2).” MPEP § 1214.01.

SUMMARY

We grant Appellant's request for rehearing to the extent of designating our affirmance as a new ground of rejection but decline to change any other aspect of the previous decision.

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REHEARING GRANTED-IN-PART

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